



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/811,346	03/26/2004	Russell Bonaventura	LEAP:128US	1571

7590

10/11/2005

S. Peter Konzol, Esq.
Simpson & Simpson, PLLC
5555 Main Street
Williamsville, NY 14221-5406

EXAMINER

PRITCHETT, JOSHUA L

ART UNIT

PAPER NUMBER

2872

DATE MAILED: 10/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

EJC

Office Action Summary	Application No. 10/811,346	Applicant(s) BONAVENTURA ET AL.	
	Examiner Joshua L. Pritchett	Art Unit 2872	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>7/04, 9/04</u> . | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Claim Objections

Claims 20 and 26 are objected to because of the following informalities: claims 20 and 26 claim that two adjustment means and two removable adjustment knobs are located on opposite sides of the microscope. The claim language leave open the possibility that the two adjustment means are separate from the two adjustment knobs. The examiner suggests changing the claim language to “two adjustment means, each having a removable adjustment knob,” or some similar language to make it clear that the adjustment knob is part of the adjustment means. Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(f) he did not himself invent the subject matter sought to be patented.

Claims 1-3, 5-7, 9, 11 and 12 are rejected under 35 U.S.C. 102(f) because the applicant did not invent the claimed subject matter.

Bonaventura (US 2004/0246571) has a different inventive entity as the current application. Bonaventura (US 2004/0246571) also has no assignee while the current application is assigned to Leica Microsystems Wetzler GmbH.

Regarding claims 1 and 5, Bonaventura discloses a removable interchangeable adjustment knob (12) magnetically fastenable to an adjustment means (para. 0023).

Regarding claims 2 and 6, Bonaventure discloses the adjustment means has a rotatable shaft (para. 0023).

Regarding claims 3 and 7, Bonaventura disclose the adjustment knob is adapted for complementary magnetically attractive engagement with the adjustment means (Fig. 2; para. 0023).

Regarding claim 9, Bonaventure discloses a second adjustment means (12; Fig. 1).

Regarding claim 11, Bonaventura discloses the removable interchangeable adjustment knob is magnetically fastenable to the second adjustment means (para. 0023).

Regarding claim 12, Bonaventure discloses the adjustment means comprising a first adjustment knob (12) and a removable adjustment knob (12; Fig. 1), the first adjustment knob and the removable adjustment knob coaxial and independently rotatable with respect to one another (Fig. 1).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4, 8, 10 and 13-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bonaventura (US 2004/0246571).

Art Unit: 2872

Regarding claims 4, 8, 13, 14, 22 and 27, Bonaventura teaches the adjustment means comprise adjusting the objective lens (para. 0022). Bonaventura further teaches a rotatable shaft (para. 0023) and reliably fastening the adjustment knob (para. 0023). Bonaventura lacks specific reference to a focus means. It is extremely well known in the art that adjusting the objective lens can change the focusing of a microscope. Official Notice is taken. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have the Bonaventura invention adjust the focusing means of the microscope by adjusting the objective lens as is known in the art for the purpose of aligning the objective within the microscope (para. 0022).

Regarding claim 15, Bonaventura teaches the removable adjustment knob is fastenable by means operatively arranged for preventing separating movement of the removable adjustment knob axially away therefrom and the second means tending to allow rotation with the removable adjustment knob (para. 0023).

Regarding claims 16, 23 and 29, Bonaventura teaches the means is magnetic (para. 0023).

Regarding claims 17, 24 and 30, Bonaventura teaches the second means comprising pin (18) means extending axially from the removable adjustment knob and pin receiving means complementarily extending axially from the attached location (Fig. 2; para. 0023).

Regarding claims 18, 25 and 31, Bonaventura teaches one of the pin means and pin receiving means is formed of magnetic material and the other is magnetically attractable material (para. 0023).

Art Unit: 2872

Regarding claim 19, Bonaventura teaches the invention as claimed but lacks reference to moving the microscope stage. It is extremely well known in the art to move the microscope stage in the vertical direction to adjust the focusing of a microscope. Official Notice is taken. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have the Bonaventura invention include a microscope stage movable in a vertical direction as is known in the art for the purpose of adjusting the focusing of a microscope.

Regarding claims 20 and 26, Bonaventura teaches at least two adjustment means and two removable adjustment knobs disposed on opposite sides of the microscope (Fig. 1).

Regarding claims 21, 28 and 32, Bonaventura teaches the invention as claimed but lacks reference to one adjustment knob being longer than the other. It has been held (*In re Reinhart*) that changes in size are within the skill of one of ordinary skill in the art at the time the invention was made. One would have been motivated to change the size of one of the adjustment knobs for the purpose of connecting to a magnetic socket deeper within the body of the microscope.

Conclusion

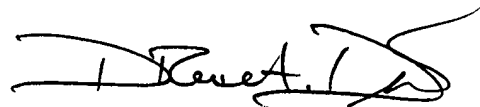
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joshua L. Pritchett whose telephone number is 571-272-2318. The examiner can normally be reached on Monday - Friday 7:00 - 3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew A. Dunn can be reached on 571-272-2312. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2872

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JLP *W*



DREW A. DUNN
SUPERVISORY PATENT EXAMINER